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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,322	02/06/2004	Sam Michael Sarmast	200314430-1	8533

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EXAMINER

GARCIA JR, RENE

ART UNIT PAPER NUMBER

2853

DATE MAILED: 08/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/774,322		SARMAST ET AL.	
	Examiner		Art Unit	
	Rene Garcia, Jr.		2853	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11, 13-15, 17-24, 27 and 29-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11, 13-15, 17-24, 27 and 29-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Withdraw of Allowable Subject Matter

1. The indicated allowable subject matter of claims 1-9, 11, 13, 14, 15 and 17-25 is withdrawn. These claims have 35 USC 101 issues that must be overcome as outlined below.

Claim Objections

2. Claims 3 and 4 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. With regards to claim 3, the recitation of a pull down resistor adds no new method step(s) not already presented in claims form which it depends. With regards to claim 4, pull down resistor being coupled to a line adds no new method step(s) not already presented in claims from which it depends. It has been held that to be entitled to weight in method claims, the recited-structure limitations therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure. *Ex parte Pfeiffer, 1962 C.D. 408 (1961)*.

3. Claim 27 recites the limitation "the means for encoding" in line 7. There is insufficient antecedent basis for this limitation in the claim.

4. Claim 27 is objected to because of the following informalities: last line of claim has grammatical structure issues. The statement "wherein the encoder encodes information changes..." i.e. does not flow properly, perhaps "...encoder encoded...". Appropriate correction is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1, 2, 5, 6, 7, 8, 11, 13, 14, 15, 17, 18, 19 and 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims fail to produce a tangible result, i.e. [with regards to claims 1 and 11] determining a plurality of operating of parameters of the fluid ejection device based upon the first and second identification information is considered an abstract step. With regards to: claim 2 - querying a portion of the fluid ejection device; claim 5 - determining a resistance value at the pull down resistor; claims 6 and 14 – determining a voltage magnitude at the pull down resistor; claim 7 – querying a first portion of the fluid ejection device and querying at least one other portion of the fluid ejection device; claim 8, querying the identification elements based upon the protocol; claim 13 – determining a magnitude of a resistance of the at least one pull down resistor; claim 15 – providing signals based upon the protocol; claim 17 – providing signals to the identification elements; claim 18 – determining the protocol based on the magnitude; claim 19 – determining a magnitude of a resistance; claim 20 – first magnitude is indicative of the at least one operating parameter. The determining, querying or providing contribute to no claimed tangible result (i.e. what is done with it) therefore making them abstract.

7. Claims 3, 4, 12 and 21-25 are rejected because the claims are dependent upon claims rejected under 35 U.S.C. 101, and therefore any 35 U.S.C. 101 rejections must be resolved.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claim 27 is rejected under 35 U.S.C. 112, first paragraph, because the claims recite a single means claims i.e., where a means recitation does not appear in combination with another recited element of means, therefore is subject to an undue breadth rejection.

See MPEP § 2164.08(a).

10. Claims 28-32 are rejected because they are dependent upon claim 27, and therefore any 35 U.S.C. 112 first paragraph rejections must be resolved.


Art Unit: 2853


Communications with the USPTO

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rene Garcia, Jr. whose telephone number is (571) 272-5980. The examiner can normally be reached on M-F 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen D. Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Rene Garcia Jr
08/06


STEPHEN MEIER
SUPERVISORY PATENT EXAMINER